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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,460	03/06/2006	Peter Hudson	023234-0106	8207

22428 7590 04/09/2007  
FOLEY AND LARDNER LLP  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER
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COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
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1624

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/09/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/541,460

Applicant(s)

HUDSON ET AL.

Examiner

Brenda L. Coleman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6,36-40,50-53 and 55-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,36-40,50-53 and 55-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/6/05 &amp; 3/6/06</u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1-6, 36-40, 50-53 and 55-63 are pending in the application.

#### ***Election/Restrictions***

1. Applicant's election of Group V in the reply filed on January 8, 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 1-6, 36-40, 50-53 and 55-63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a) Claim 1 recites the limitation "2-cyclopropyl-ethyl" in the second species listed on page 4. There is insufficient antecedent basis for this limitation in the claim.
- b) Claim 1 recites the limitation "cyclopentylmethyl" in the seventh species listed on page 4. There is insufficient antecedent basis for this limitation in the claim.
- c) Claim 1 recites the limitation "cyclohexylmethyl" in the eighth species listed on page 4. There is insufficient antecedent basis for this limitation in the claim.

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- d) Claim 1 recites the limitation "cyclobutylmethyl" in the 1<sup>st</sup>, 2<sup>nd</sup>, 9<sup>th</sup>, 10<sup>th</sup>, 11<sup>th</sup>, 13<sup>th</sup>, 15<sup>th</sup> and 17<sup>th</sup> species listed on page 5. There is insufficient antecedent basis for this limitation in the claim.
- e) Claim 1 recites the limitation "2-cyclopropyl-ethyl" in the third species listed on page 5. There is insufficient antecedent basis for this limitation in the claim.
- f) Claims 4-6 are a substantial duplicate of claim 2. A statement of intended use is not given material weight. Note *In re Tuominen* 213 USPQ 89.
- g) Claim 62 recites the limitation "2-cyclopropyl-ethyl" in the 4<sup>th</sup> species listed on page 10. There is insufficient antecedent basis for this limitation in the claim.
- h) Claim 62 recites the limitation "cyclopentylmethyl" in the 9<sup>th</sup> species listed on page 10. There is insufficient antecedent basis for this limitation in the claim.
- i) Claim 62 recites the limitation "cyclohexylmethyl" in the 10<sup>th</sup> species listed on page 10. There is insufficient antecedent basis for this limitation in the claim.
- j) Claim 62 recites the limitation "cyclobutylmethyl" in the 2<sup>nd</sup>, 3<sup>rd</sup>, 10<sup>th</sup>, 11<sup>th</sup>, 12<sup>th</sup>, 14<sup>th</sup> and 16<sup>th</sup> species listed on page 11. There is insufficient antecedent basis for this limitation in the claim.
- k) Claim 62 recites the limitation "2-cyclopropyl-ethyl" in the 4<sup>th</sup> species listed on page 11. There is insufficient antecedent basis for this limitation in the claim.
- l) Claim 62 recites the limitation "cyclobutylmethyl" in the 1<sup>st</sup> species listed on page 12. There is insufficient antecedent basis for this limitation in the claim.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-6, 36-40, 51 and 55-63 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/570,628. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds, compositions and method of use of the compounds of formula 1 of the instant invention embrace the compounds, compositions and method of use of the compounds of formula I in 10/570,628 wherein R<sup>1</sup> is methyl or Cl, R<sup>2</sup> and R<sup>3</sup> are both H, X<sup>1</sup> is NH, a is 1, b is 2, A<sup>4</sup>, A<sup>5</sup> and A<sup>10</sup> are all CH, A<sup>6</sup> is NH, A<sup>7</sup> and A<sup>11</sup> are both C, A<sup>8</sup> is N-(CH<sub>2</sub>)<sub>d</sub>-R<sup>7</sup> and A<sup>9</sup> is N.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-6, 36-40, 50-53 and 55-63 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 18-30, 70, 71, 73 and 74 of copending Application No. 11/659,798. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds, compositions and method of use of the compounds of formula 1 of the instant invention embrace the compounds and compositions of the compounds of formula 1b in 11/659,798 wherein G<sup>1</sup> is formula 3b.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6, 16-19, 21-32, 35 and 36 of copending Application No. 10/486,715. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds, compositions and method of use of the compounds of formula 1 of the instant invention embrace the compounds, compositions and method of use of the compounds of formula 1 in 10/486,715 wherein G<sup>1</sup> is formula 6.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Brenda L. Coleman  
Primary Examiner Art Unit 1624  
April 1, 2007